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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,956	03/03/2004	Roman M. Golicz	2223	5057
28152	7590	03/01/2007		
CHARLES G. NESSLER P.O. BOX H CHESTER, CT 06412			EXAMINER MCCLELLAND, KIMBERLY KEIL	
			ART UNIT 1734	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/01/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/791,956

Applicant(s)

GOLICZ ET AL.

Examiner

Kimberly K. McClelland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25,27-32,34,35,38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 34-35 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 6-15,22 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/3/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/11/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-33 and 39 in the reply filed on May 31<sup>st</sup>, 2006 is acknowledged. The traversal is on the ground(s) that the process claims cannot be practiced with a materially different process from that of the apparatus. This is not found persuasive because the apparatus claims are not a process. The process as claimed can be used to practice a materially different apparatus. For example, the web may be contoured with rollers, instead of belt means.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims 34-35 and 38 drawn to an invention nonelected with traverse in Paper No. 5/31/06. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Response to Amendment***

2. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 5714.02 and j2163.06. See 37 CFR 1.111.

### ***Claim Objections***

3. Claim 13 is objected to because of the following informalities: The word "of" in line 1 should be changed to "or". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Means for receiving the labels contours the label does not appear to have support in the specification. Applicant is invited to clarify where the support for this limitation can be found, if support exists.

6. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase, "only a pair of spaced apart rings" does not appear to have support in the specification. Applicant is invited to clarify where the support for this limitation can be found, if support exists.

7. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

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the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase, "means for receiving and transporting imparts a linear velocity" does not appear to have support in the specification. Applicant is invited to clarify where the support for this limitation can be found, if support exists.

8. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrases, "cuts only partially through" and "sufficiently to tear and separate the web at the point of partial cutting" do not appear to have support in the specification. Applicant is invited to clarify where the support for this limitation can be found, if support exists.

9. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Means for comparing the length of each indicia pair does not appear to have support in the specification. Applicant is invited to clarify where the support for this limitation can be found, if support exists.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the structure or means of the apparatus, which serve to contour the web. Further, claim 32 contains no reference to any patentable material drawn to an apparatus.

12. Claim 32 provides for the use of an apparatus, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

13. Claim 32 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### ***Claim Rejections - 35 USC § 102***

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims 27-29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,253,817 to Edwards.

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16. With respect to claim 27, Edwards et al. discloses an apparatus for preparing labels, including a source of label material in web form (70), the web having spaced apart indicia which are readable by a sensor; means for feeding said web along a flow path toward a means for cutting (column 11, lines 31-50); means for cutting (80,100) said web to form labels (70a, 70b); means for receiving said labels from the cutting means (80, column 12, lines 23-31); a first sensor (172), positioned downstream of the cutting means, for sensing indicia lengths; mean for comparing lengths of portions of an indicium which is severed during forming of a label, based on first sensor reading information; and means for adjusting the length of a subsequent label, according to how the lengths of the indicium portions during the forming of a label (See Figure 3, and column 12, lines 33-64).

17. As to claim 28, Edwards et al. discloses a source of label material (44) in web form (70, See Figures 3 and 7); means for feeding said web along a flow path toward a means for cutting; means for cutting (80) said web to form labels (112); means for receiving said labels from the cutter assembly; a first sensor (172), positioned downstream of the cutting means, for reading indicia lengths; wherein said first sensor is capable of sensing the indicia lengths on a label or web end just formed by cutting of said web; means for comparing the length of each indicia pair as measured by the first sensor with the predetermined known lengths of each indicia on the web prior to cutting of the label; and means for adjusting the length of the web which is subsequently cut, according to whether not the first sensor detects any indicium has been cut (See Figure 3, and column 12, lines 33-64).

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18. As to claim 29, Edwards et al. discloses the means for adjusting comprises changing the amount of web, which is fed along the flow path prior to cutting of a label (column 12, lines 33-64).

19. As to claim 31, Edwards et al. discloses the label length is changed according to whether or not there is mutually in length of portions of any severed indicium (column 12, lines 33-64).

20. Claim 32 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 3,353,432 to Philippi.

21. With respect to claim 32, no structural limitations are given in the claim. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Phillippi discloses a tape feeding device, including contouring the web in a plane, which is transverse to the flow path, to increase the stiffness of the cantilevered portion of the web (column 2, lines 12-29).

22. Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,204,672 to Grivet.



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23. With respect to claim 32, no structural limitations are given in the claim. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Grivet discloses a sheet processing machine, including contouring the web in a plane, which is transverse to the flow path, to increase the stiffness of the cantilevered portion of the web (column 3, lines 9-12).

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of U.S. Patent No. 3,353,432 to Philippi and in view of U.S. Patent No. 4,204,672 to Grivet.

26. With respect to claim 1, applicant's admitted prior art discloses feeding means for feeding web along a flow path to a cutter assembly; and a cutter assembly spaced apart from the feeding means, for cutting the web repetitively, to form labels (Claim 32).

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27. Phillippi discloses a tape feeding device, including belt means for feeding along a flow path to a cutter assembly, for contouring the web in a plane which is transverse to the flow path, and for projecting the web into space toward a cutter (column 2, lines 12-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the feeding means disclosed by Phillippi et al. with the apparatus disclosed in applicant's admitted prior art. The motivation would have been to give the web rigidity for feeding purposes (column 2, lines 12-15).

28. Grivet discloses a device for conveying sheets, including means for receiving the sheets from a first station (See abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the receiving means disclosed by Grivet with the apparatus disclosed in applicant's admitted prior art. The motivation would have been to collect the labels after being cut.

29. As to claim 2, applicant's admitted prior art does not disclose receiving means. Grivet discloses the means for receiving sheets transports the sheets away from the first station along a continuation of said flow path (See Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the receiving means disclosed by Grivet after the cutting apparatus disclosed in applicant's admitted prior art. The motivation would have been to collect the labels after being cut.

30. As to claim 3, applicant's admitted prior art does not disclose receiving means. Grivet discloses the means for receiving sheets contours the sheets in a plane transverse to the flow path as the sheets are transported away (column 3, lines 9-12). It

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would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the receiving means disclosed by Grivet with the apparatus disclosed in applicant's admitted prior art. The motivation would have been to prevent jam-ups in the apparatus during transportation of the sheets (column 1, lines 45-51).

31. As to claim 4, applicant's admitted prior art does not disclose the source of web. Philippi discloses a tape feeding device, including a source of web in roll form (23), and means for delivering web from roll to the upstream end of the means for feeding the web (column 2, lines 12-29) and is capable of causing the web to move along a free loop path (column 3, lines 52-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the feeding means disclosed by Philippi et al. with the apparatus disclosed in applicant's admitted prior art. The motivation would have been to give the web rigidity for feeding purposes (column 2, lines 12-15).

The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the

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structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). If the applicant were to establish that significant structural differences exist with the prior art apparatus which would make it incapable of performing the free loop forming step and amend the claims appropriately, the art rejection over the apparatus claims will be withdrawn. See MPEP § 2114.

32. As to claim 5, applicant's admitted prior art discloses a web with labels (see claim 32). However, applicant's admitted prior art does not disclose the contour of is concave. Philippi discloses a tape feeding device, including the contour of web and labels is concave when viewed from the release side of the web material (column 3, lines 34-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the feeding means disclosed by Phillippi et al. with the apparatus disclosed in applicant's admitted prior art. The motivation would have been to give the web rigidity for feeding purposes (column 2, lines 12-15).

33. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of U.S. Patent No. 3,353,432 to Philippi and in view of U.S. Patent No. 4,204,672 to Grivet as applied to claims 1-5 above, and further in view of U.S. Patent No. 5,674,345 to Nash.

34. As to claim 16, applicant's admitted prior art does not disclose an upstream roller and a downstream roller; at least one endless belts, running around the rollers, for contacting the adhesive side of the web, to thereby move the web along said flow path; wherein the downstream roller has only a pair or; spaced apart circumferential rings

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straddling the roller region upon which the belt or belt runs, the rings having outside diameters greater than the outside diameter of the surface of the belt or belts running around said roller. Philippi discloses a tape feeding device, including an upstream roller and a downstream roller; at least one endless belts, running around the rollers, for contacting the adhesive side of the web, to thereby move the web along said flow path (column 2, lines 12-29); wherein the downstream roller has only a pair of spaced apart circumferential rings (81) straddling the roller region upon which the belt or belt runs (11), the rings having outside (See Figure 7).

35. Nash discloses an apparatus for printing linerless labels, including an upstream roller and a downstream roller; at least one endless belts, running around the rollers, for contacting the adhesive side of the web, to thereby move the web along said flow path; wherein the downstream roller has only a pair or; spaced apart circumferential rings straddling the roller region upon which the belt or belt runs, the rings (183) having outside diameters greater than the outside diameter of the surface of the belt or belts running around said roller (See Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the upstream and downstream rollers disclosed by Nash with the apparatus disclosed in applicant's admitted prior art. The motivation would have been to support the belt means during transportation of the web (column 2, lines 12-15).

36. Claims 17, 21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of U.S. Patent No. 3,353,432 to

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Philippi and in view of U.S. Patent No. 4,204,672 to Grivet as applied to claims 1-5 above, and further in view of U.S. Patent No. 6,655,435 to Penati et al.

37. With respect to claim 17, applicant's admitted prior art discloses a feeder which feeds web into and through the gap of a cutter which is spaced apart from the feeder, so the cutter can form labels by cutting the web into portions wherein the feeder causes an end of the web to cantilever outwardly, from the feeder and extend through said gap (See claim 32). However, applicant's admitted prior art does not disclose the cutter assembly is a rotatable knife, belt means for feeding, or means for receiving the label.

38. Penati et al. discloses a system for creating linerless pressure sensitive coil of stamps, including the cutter assembly comprises: a rotatable knife and an opposing rotatable anvil (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cutter assembly of Penati et al. with the cutter assembly disclosed by applicant's admitted prior art. The motivation would have been to allow consistent cutting of the label.

39. Phillippi discloses a tape feeding device, including belt means for feeding along a flow path to a cutter assembly, for contouring the web in a plane which is transverse to the flow path, and for projecting the web into space toward a cutter (column 2, lines 12-29), and means for receiving the end of the web for transporting labels cut from the web by the cutter assembly in a direction which is a continuation of the web flow path into the cutter assembly (column 7, lines 60-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the feeding means and receiving means disclosed by Phillippi et al. with the apparatus disclosed in

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applicant's admitted prior art. The motivation would have been to give the web rigidity for feeding purposes (column 2, lines 12-15).

40. As to claim 21, applicant's admitted prior art does not disclose at least three spaced apart endless belts.

41. Phillippi discloses a tape feeding device, including at least three spaced apart endless belts running around a set of spaced apart rollers (33; See Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the feeding means and receiving means disclosed by Phillippi et al. with the apparatus disclosed in applicant's admitted prior art. The motivation would have been to effectively propel the web during the transport of the web (column 4, lines 65-70).

42. As to claim 23, applicant's admitted prior art does not disclose the cutter assembly comprises: a rotatable knife; an opposing rotatable anvil; and means for cooling the anvil.

43. Penati et al. discloses a system for creating linerless pressure sensitive coil of stamps, including the cutter assembly comprises: a rotatable knife; an opposing rotatable anvil; and means for cooling the anvil (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cutter assembly of Penati et al. with the cutter assembly disclosed by applicant's admitted prior art. The motivation would have been to deactivate the adhesive portion of the label to allow cutting of the label (column 4, lines 55-60).

44. As to claim 24, applicant's admitted prior art does not disclose the cutter assembly comprises: a rotatable knife cylinder with knife; an opposing rotatable

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cylindrical anvil in contact with the knife cylinder; and, means for resiliently pressing together the knife cylinder and the anvil, so that cylindrical rotation of either rotates the other by frictional engagement therebetween.

45. Penati et al. discloses a system for creating linerless pressure sensitive coil of stamps, including the cutter assembly comprises: a rotatable knife cylinder with knife; an opposing rotatable cylindrical anvil in contact with the knife cylinder; and, means for resiliently pressing together the knife cylinder and the anvil, so that cylindrical rotation of either rotates the other by frictional engagement therebetween (See column 4, lines 11-14 and Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cutter assembly of Penati et al. with the cutter assembly disclosed by applicant's admitted prior art. The motivation would have been to effectively cut the web to form a label.

46. As to claim 25, applicant's admitted prior art does not disclose the cylindrical surface of the anvil which mates with the knife cylinder during rotation of the knife cylinder ~has a circumference which is different from the circumference of the path of the tip of the knife, so that the knife tip mates with a different circumferential part of the anvil each time the knife cylinder is fully rotated.

47. Penati et al. discloses a system for creating linerless pressure sensitive coil of stamps, including the cylindrical surface of the anvil (28) which mates with the knife cylinder (30) during rotation of the knife cylinder has a circumference which is different from the circumference of the path of the tip of the knife, so that the knife tip mates with a different circumferential part of the anvil each time the knife cylinder is fully rotated.



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(See Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cutter assembly of Penati et al. with the cutter assembly disclosed by applicant's admitted prior art. The motivation would have been to effectively cut the web to form a label.

48. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of U.S. Patent No. 3,353,432 to Philippi, U.S. Patent No. 4,204,672 to Grivet, and U.S. Patent No. 6,655,435 to Penati et al as applied to claims 17, 21, and 22-25 above, and further in view of U.S. Patent No. 4,840,696 to Krasuski et al.

49. With respect to claim 18, applicant's admitted prior art does not disclose the velocity of the label.

50. Krasuski et al. discloses a label dispenser, including the means for receiving the label imparts a linear velocity in the direction of the web flow path to a label which is greater than the linear velocity of the web being moved into the gap of the cutter assembly (see Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the higher linear velocity taught by Krasuski et al. with the assembly disclosed by applicant's admitted prior art. The motivation would have been to effectively cut the web to form a label of differing lengths (column 2, lines 22-31).

51. As to claim 19, applicant's admitted prior art does not disclose partially cutting the web.

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52. Penati et al. discloses a system for creating linerless pressure sensitive coil of stamps, including the cutter assembly cuts partially through the web thickness, and, wherein the means for receiving and transporting pulls on the web sufficiently to tear and separate the web at the point of partial cutting thereby to form the label. (column 5, lines 36-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cutter assembly of Penati et al. with the cutter assembly disclosed by applicant's admitted prior art. The motivation would have been to effectively cut the web to form a label (See Figure 7).

53. As to claim 20, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). Also, this language is considered functional and directed to intended use of the apparatus. Applicant's admitted prior art is capable of using a web positioned within the apparatus along the web flow path; the web having an adhesive and a release side; wherein the release side is oriented toward the cutter cylinder and cutter knife.

54. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,253,817 to Edwards et al. as applied to claims 27-29 and 31 above, and further in view of U.S. Patent No. 6,783,622 to Backlund et al.

55. With respect to claim 30, Edwards et al. discloses an apparatus for preparing labels, including a means for cutting (column 11, lines 31-50). However, Edwards et al. does not disclose a rotary knife cylinder and mating anvil. Backlund et al. discloses an

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apparatus for producing webs of material, including a cutter assembly, which comprises a rotatable cylinder with a knife (1), and an opposing rotatable anvil (2), and means for adjusting, including changing the speed or timing of the rotation of the knife cylinder (See Figure 1, and column 3, lines 60-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cutting means and adjusting means of Backlund et al. with the apparatus of Edwards et al. The motivation would have been to provide better control and synchronization of the apparatus (Backlund et al., column 2, lines 49-60)

#### ***Allowable Subject Matter***

56. Claims 6-15, 22, and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

57. Applicant's arguments with respect to claims 1-32 and 39 have been considered but are moot in view of the new ground(s) of rejection. Any remaining pertinent arguments are addressed below:

58. As to applicant's argument against the rejection of claim 16 over Nash (page 4), examiner disagrees. Applicant argues the rings disclosed in Nash are not being used for the same purpose as the contouring rings of claim 16. Examiner would like to note that claim 16 does not disclose contouring of any kind. Furthermore, it is clearly

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established that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

59. With respect to applicant's argument against the rejection of claims 27-29 and 31 over Edwards (page 5), examiner disagrees. Applicant argues that the apparatus is only capable of sensing indicia position, not indicia length. However, the disclosure of Edwards requires "scanning of the indicia or characters imprinted on the laminated web structure" (column 12, lines 49-51). Examiner asserts that any sensing of indicia position would include the length of the indicia. Furthermore, the structure of Edwards is capable of meeting the structural limitations required by sensing the length of the label indicia. Edwards further discloses "the apparatus may include suitable structure for ejecting the incorrectly severed segments of the laminated web, and concurrently provide for an adjustment in the web feed mechanism of the apparatus" (column 12, lines 57-61). The sensing device of Edwards detects the positioning, which includes the length, of the indicia in order to establish proper displacement and severing of the web. Column 13, lines 35-49 of Edwards describe the sensing unit provides a pixel image of each printed field. Such information inherently includes indicia length. Consequently, applicant's arguments are not persuasive.

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***Conclusion***

60. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly K. McClelland whose telephone number is (571) 272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Fri..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris A. Fiorilla can be reached on (571)272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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KKM



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SUPERVISORY PATENT EXAMINER

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